

REMARKS

The Examiner finally rejects claims 9-16, 19-20, but allows claims 1-8, 17 and 18 and, moreover, indicates that claims 22 and 23 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent format.

While the Examiner is thanked for the allowance of claims 1-8 and 17-18 and the indication of allowable subject matter of claims 22-23, the Applicant hereby requests the Examiner to reconsider the rejections of claims 9-16, 19-20.

The Examiner rejects claim 9 basically on two grounds.

First, the Examiner asserts that the Examiner does not have to give any patentable weight to the preamble limitation.

Second, the Examiner asserts that plug 42 is “electrically isolated” from contact region 38b.

Turning to the first point, namely the Examiner’s assertion that the Examiner can overlook preamble limitations, it is submitted that the Examiner’s assertion is not well taken. Indeed, the Court of Appeals for the Federal Circuit has said otherwise. See, for example, *Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 9 USPQ2d 1962 (Fed. Cir. 1989) and *Catalina Mktg. Int’l v. Coolsavings.com* 62 USPQ2d 1781 (Fed. Cir. 2002). Note, in particular, the following test set forth by the Court in the case of *Catalina Mktg.*:

“No litmus test defines when a preamble limits claim scope...Some guideposts, however, have emerged from various cases discussing the preamble’s effect on claim scope. For example, this court has held that Jepson claiming generally indicates intent to use the preamble to define the claimed invention, thereby limiting claim scope...Additionally dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope ... Likewise when the preamble is essential to understand limitations or terms in the claim body ... Further when reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation...Moreover, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation ... Without such reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble does not affect the structure or steps of the claimed invention.”

The position being taken by the Examiner is clearly at odds with the Federal Circuit.

With respect to the second point raised by the Examiner, does the Examiner seriously believe that a gate structure is “electrically isolated” from the source and drain structures which it controls? The two may be physically separated, but they are hardly “electrically isolated” from one another. Indeed, what happens on the gate has a lot to do with what happens in the source and drain regions.

It is believed, with all due respect to the Examiner, that the Examiner’s assertion appears to be directly contrary to the teaching of the reference. It appears that the Examiner’s assertion is based upon facts “within the personal knowledge of an employee of the office” as opposed to being based upon this prior art document. As such, the Applicant is entitled to request the Examiner to put forth his assertions in Affidavit format. Please see 37 CFR 1.104(d)(2). The Applicant hereby requests that the Examiner, in accordance with the Rules of Practice, set forth his assertions in Affidavit format.

According to the Examiner’s analysis, if a FET transistor were placed in the Examiner’s hands, the Examiner would say that the gate, drain and source electrodes are all “electrically isolated” from one another. To be consistent, the Examiner would also have to take the position that the electrodes of a capacitor are “electrically isolated” from one other. But, if that were really true, why do electrical engineers even bother to put capacitors and FET transistors into circuits? The reason is that the electrodes of a capacitor are not “electrically isolated” from one another nor are the source, drain and gate electrodes of FET transistors “electrically isolated” from one another. It is exactly because they are not “electrically isolated” from each other that these devices provide useful functions in circuits.

The Examiner’s assertions to the contrary fly in the face of common knowledge in the electrical arts and therefore the Examiner is requested to put his assertions into Affidavit format as clearly required by the Rules of Practice.

The Examiner is respectfully requested to reconsider the rejection of the claims in this application based upon Lee, to withdraw those rejections and allow this application to proceed to allowance.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

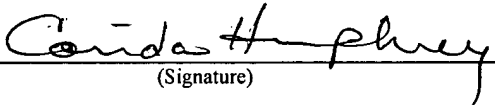
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September 13, 2004

(Date of Transmission)

Corinda Humphrey

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(Signature)

September 13, 2004

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Respectfully submitted,



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